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William C. Dengler

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM C. DENGLER

Appeal 2009-000127
Application 10/027,073
Technology Center 3600

Decided: ¹ May 29, 2009

Before LINDA E. HORNER, MICHAEL W. O'NEILL, and
STEFAN STAICOVICI, *Administrative Patent Judges*.

STAICOVICI, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

William C. Dengler (Appellant) appeals under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 33-49. Claims 1-32 have been canceled. We have jurisdiction over this appeal under 35 U.S.C. § 6(b) (2002).

THE INVENTION

The Appellant's invention is drawn towards a system and a process for providing ongoing medical care to a patient by coordinating delivery of medical care services from multiple healthcare providers. Specification 1, ¶ [0001]. The system 10 includes a treatment center 12, a coordinating party 14 (*i.e.*, a registered nurse), a patient 16, and healthcare providers 18, such as a primary care physician (PCP) 18A, an imaging services or radiology group 18B, a medical laboratory 18C, a hospital 18D, and at least one medical specialist 18E. Specification 11-12, ¶ [0056] and fig. 1. The system 10 further includes a software program 20, one or more databases 22, a server 24, a web site 26, a personal computer 28, one or more Internet Service Providers 32 for accessing the Internet 34, and standard communications equipment 38 (*i.e.*, modem or wireless communication devices). Specification 12-13, ¶ [0059] and fig. 2. Using software 20, the coordinating party stores information received from the patient 16 into one of the databases 22 on the server 24, and contacts relevant health care providers 18 to schedule diagnostic tests ordered by the PCP 18A, or the specialist 18E. Specification 13, ¶ [0061] and 16, ¶ [0064]. After the tests have been performed and the test results have been obtained from the healthcare providers 18, the coordinating party 14 uses software 20 to

publish a summary 108 of the test results, which is downloaded to the database 22, and is made available to the patient 16, to any PCP 18A, or to any specialist 18E. Specification 19, ¶ [0070] and figs. 15A and 15B.

Claim 33 is representative of the claimed invention and reads as follows:

33. A method of coordinating management of healthcare services for a patient having a selected medical condition, comprising:
 - (a) providing a computerized information management system including:
 - (i) a server including a database operable to receive and store for retrieval data from an information source regarding a patient which is collected by a coordinating party; and
 - (ii) at least one computer communicating with the database via a communications network for processing the data so as to permit a user to access the data;
 - (b) selecting a plurality of tests to be conducted on the patient, the tests selected to diagnose the selected medical condition or an aspect thereof; and storing in the database a list of the tests so as to enable tracking of the completion status of the tests using the computer;
 - (c) for each of the tests, using the computer to solicit from the user a subset of test results selected from the set of possible results for that test; and storing the subset of test results in the database; and

- (d) creating a summary which simultaneously displays the subsets of test results for all of the selected tests for use by a health care provider in selecting a treatment track for treatment of the selected medical condition based on the test results; and storing the summary in the database.

EVIDENCE RELIED UPON

The Examiner relies upon the following as evidence of unpatentability:

Teagarden	US 6,014,631	Jan. 11, 2000
Coli	US 6,018,713	Jan. 25, 2000
Bair	US 6,108,665	Aug. 22, 2000
Kraftson	US 6,151,581	Nov. 21, 2000

The Appellant relies on the following as evidence of non-obviousness:
Declaration under 37 C.F.R. § 1.132 of Charles M. Nunn, Jr., MD, filed May 18, 2004 (hereafter “Nunn Declaration”).

THE REJECTIONS

The following rejections are before us for review:

The Examiner rejected claims 33-39 under 35 U.S.C. § 103(a) as unpatentable over Coli in view of Bair.

The Examiner rejected claims 40-48 under 35 U.S.C. § 103(a) as unpatentable over Coli in view of Bair and Teagarden.

The Examiner rejected claim 49 under 35 U.S.C. § 103(a) as unpatentable over Coli in view of Bair and Kraftson.

THE ISSUES

1. Has the Appellant demonstrated that the Examiner erred in determining that Coli discloses: (i) using a computer to solicit from the user a subset of test results selected from the set of possible results for that test, and (ii) creating a summary which simultaneously displays the subsets of test results for all of the selected tests, as required by independent claims 33 and 40?
2. Has the Appellant shown that the Examiner erred in determining that the claimed invention would have been obvious in view of the teachings of Coli and Bair?

SUMMARY OF DECISION

We AFFIRM.

FINDINGS OF FACT

The following enumerated findings of facts (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Coli discloses a network-based system 200 for medical test ordering and results reporting, including a hospital computer 202 operated by a physician or other medical specialist (a user), a labsite computer 204 operated by a lab technician, a physician computer 206 operated by a physician (a user), an insurer computer 208, a computer network 211 to connect the computers 202, 204, 206 and 208, a patient database computer 214 (server), and software for each computer and the database server. Coli, col. 9, ll. 4-17 and fig. 2.

2. The physician uses hospital computer 202 or physician computer 206 to access network 211 to either order medical tests or generate a report of test results previously performed. Coli, col. 10, ll. 42-46 and 53-56; and fig. 4.
3. If the physician desires to order a test, the physician enters the patient's demographic information, orders (selects) one or more medical tests from a plurality of available individual medical tests, associates a diagnostic code for the patient's condition with the test order, and selects the laboratory for performing the tests. Coli, col. 11, ll. 14-26 and 57-61; col. 12, ll. 29-34; and fig. 6.
4. The individual tests are organized into two major categories: (a) biochemical and microbiological tests, and (b) medical subspecialty tests (*e.g.*, diagnostic radiology, multi-modality imaging, surgical pathology, cytology, cytogenetics, and blood bank). The first category is further divided into five subcategories: (i) basic hematology; (ii) urinalysis; (iii) basic chemistry; (iv) special chemistry; and (v) microbiology. Coli, col. 11, ll. 31-38 and fig. 6.
5. If the physician decides to generate a report of the test results of a particular patient within a specified range of dates, the software displays the categories and subcategories of the test results ordered for that patient. Using the physician's computer 206 or another hospital computer 202, the physician then selects particular categories or subcategories of test results to

view and/or print within the specified range of dates. Coli, col. 13, ll. 30-47 and figs. 10 and 11.

6. The test results are transmitted from the patient database computer 214 formatted for “cumulative results reporting,” and displayed and/or printed for the physician or lab technician (user) in an organization identical to the organization of the tests for ordering purposes. Coli, col. 14, ll. 7-15. The test results are organized in a standardized format, with patient identification, date and time identification, test result values, and any “lab notes.” Coli, col. 14, ll. 36-38.
7. An ordinary and customary meaning of the term “cumulative” is “made up of accumulated parts.” MERRIAM WEBSTER'S COLLEGIATE DICTIONARY 283 (10th ed. 1997).
8. The Heartburn Treatment Center uses an “Internet-based integrated healthcare delivery system... to create patient plans of care, to schedule diagnostic procedures and store the results thereof, and to track patient follow up.” Nunn Declaration, ¶ 2.
9. Since the Heartburn Treatment Center was established 29 surgical procedures have been performed. Nunn Declaration, ¶ 3.
10. In the year prior to establishing the Heartburn Treatment Center, 12 manometry procedures were performed, whereas in the period from January 2003 through April 2004, 66 manometry procedures were performed. Nunn Declaration, ¶ 4.
11. In the year prior to establishing the Heartburn Treatment Center, no PH studies were performed, whereas in the period

from January 2003 through April 2004, 112 PH studies were performed. Nunn Declaration, ¶ 5.

12. The Heartburn Treatment Center has sixty referring physicians and health services groups, has received 87 self-referrals, and has added 319 new patients. Nunn Declaration, ¶¶ 7-9.

PRINCIPLES OF LAW

Obviousness

It is elementary that to support an obviousness rejection “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

Secondary Considerations

The Examiner has the initial burden of showing a *prima facie* case of obviousness, and the Appellant has the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“[t]o reject claims in an application under section 103, an examiner must show an unrebutted *prima facie* case of obviousness ...On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

When the Appellant provides rebuttal evidence, the Board must start anew, and weigh the evidence upon which the earlier conclusion of obviousness was reached against the facts established by the rebuttal evidence to reach a legal conclusion of obviousness or non-obviousness. *See*

In re Piasecki, 745 F.2d 1468, 1472-73 (Fed. Cir. 1984) and *In re Rinehart*, 531 F.2d 1048, 1052 (CCPA 1976).

To be given substantial weight in the determination of obviousness or non-obviousness, evidence of secondary considerations must be relevant to the subject matter as claimed, and therefore, the examiner must determine whether there is a nexus between the merits of the claimed invention and the evidence of secondary considerations. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 306 n.42 (Fed. Cir. 1985), In particular, an applicant asserting secondary considerations to support its contention of non-obviousness bears the burden of proof of establishing a nexus between the claimed invention and evidence of secondary considerations. For example, in the case of evidence of commercial success, the Federal Circuit has acknowledged that the applicant bears the burden of establishing a nexus, stating:

In the *ex parte* process of examining a patent application, however, the PTO lacks the means or resources to gather evidence which supports or refutes the applicant's assertion that the sales constitutes commercial success. *Cf. Ex parte Remark*, 15 USPQ2d 1498, 1503 (Bd. Pat. App. & Int. 1990) (evidentiary routine of shifting burdens in civil proceedings inappropriate in *ex parte* prosecution proceedings because examiner has no available means for adducing evidence). Consequently, the PTO must rely upon the applicant to provide hard evidence of commercial success.

In re Huang, 100 F.3d 135, 139-40 (Fed. Cir. 1996). *See also In re GPAC*, 57 F.3d 1573, 1580 (Fed. Cir. 1995) and *In re Paulsen*, 30 F.3d 1475, 1482 (Fed. Cir. 1994) (Evidence of commercial success of articles not covered by

the claims subject to the obviousness rejection was not probative of non-obviousness).

Objective evidence of non-obviousness, including commercial success, must be commensurate in scope with the claims. *See In re Tiffin*, 448 F.2d 791, 792 (CCPA 1971) (evidence showing commercial success of thermoplastic foam "cups" used in vending machines was not commensurate in scope with claims directed to thermoplastic foam "containers" broadly). In order to be commensurate in scope with the claims, the commercial success must be due to claimed features, and not due to unclaimed features. *Joy Technologies Inc. v. Manbeck*, 751 F. Supp. 225, 230 (D.D.C. 1990), *aff'd*, 959 F.2d 226, 228 (Fed. Cir. 1992) (Features responsible for commercial success were recited only in allowed dependent claims, and therefore the evidence of commercial success was not commensurate in scope with the broad claims at issue). Gross sales figures do not show commercial success absent evidence as to market share, *Cable Electric Prods., Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1026-27 (Fed. Cir. 1985), as to the time period during which the product was sold, or as to what sales would normally be expected in the market, *Ex parte Standish*, 10 USPQ2d 1454, 1458 (BPAI 1988).

OPINION

Issue (1)

Claims 33-39

The Appellant argues the rejection of claims 33-39 under 35 U.S.C. §103(a) together as a group. Therefore, in accordance with 37 C.F.R. 41.37(c)(1)(vii) (2008), we have selected claim 33 as the representative

claim to decide the appeal, with claims 34-39 standing or falling with claim 33.

The Appellant argues that a computer is not used in the process of Coli to “solicit from the physician (or any other user) a subset of test results which are selected from a set of possible test results for that test.” Br. 9. As found above, Coli specifically discloses a network-based system 200, used by a physician to either order medical tests or generate a report of test results previously performed. FF 1 and 2. Coli further discloses ordering (selecting) one or more medical tests from a plurality of available individual medical tests organized into categories and subcategories (selecting a plurality of tests to be performed on the patient). FF 3 and 4. Using the system of Coli, if the physician decides to generate a report of the test results of a particular patient within a *specified range of dates*, the software displays the categories and subcategories of the test results ordered for that patient within the specified range of dates. FF 5. Using the physician’s computer 206 or another hospital computer 202, the physician then selects particular categories or subcategories of test results to view and/or print within the specified range of dates. *Id.*

We agree with the Examiner that because the report of Coli includes the test results for a specific test covering a specified range of dates, these test results constitute a “subset of test results selected from the set of possible results for that test.” *See* Ans. 7. For example, the physician may be interested in tracking the evolution of a test result for a certain test performed throughout the previous 6 months, and not be interested in the test results for the same test that occurred before the 6 month period. As such, the test results for the previous 6 months constitute a “subset of test results

selected from the set of possible results for that test.” Therefore, we find that Coli specifically discloses the limitation of “using a computer to solicit from the user a subset of test results selected from the set of possible results for that test,” as required by claim 33.

The Appellant further argues that the physician, using the method and system of Coli, is not able to create a summary that displays simultaneously the subset of the test results (selected from the set of possible test results) for *all of the tests* previously ordered. At most, according to the Appellant, “the physician can only display a subset of the tests previously ordered for the patient that are arranged in the same meaningful clinical groupings.” Br. 9. As such, the Appellant argues that the physician would have to take an extra step, as compared to the claimed invention, to extract the test results from the subsets of tests displayed in the clinical groupings of Coli. Br. 9-10.

In this case, it is our finding that Coli specifically discloses that the test results are transmitted from the patient database computer 214, formatted for “cumulative results reporting,” and displayed and/or printed for the physician or lab technician (user) in an organization identical to the organization of the tests for ordering purposes. FF 6. Furthermore, Coli discloses that the test results are organized in a standardized format, with patient identification, date and time identification, test result values, and any “lab notes.” *Id.* The Examiner takes the position that because Coli discloses formatting the test results as “cumulative results reporting,” Coli discloses the claimed limitation of “creating a *summary* ‘which *simultaneously* displays the subsets of test results for all of the selected tests....’” Ans 6. (emphasis added). We agree with the Examiner. We find that an ordinary and customary meaning of the term “cumulative” is “made up of

accumulated parts.” FF 7. As such, a person of ordinary skill in the art would reasonably understand that the “cumulative” results report of Coli represents a collection of all the test results (accumulated parts) selected by the physician to be displayed, and hence represents a “summary which simultaneously displays the subsets of test results for all of the selected tests.” Therefore, in contrast to the Appellant’s position, we find that Coli specifically discloses the limitation of “creating a summary which simultaneously displays the subsets of test results for all of the selected tests,” as required by claim 33.

Issue (2)

The Appellant argues that “the Examiner has not satisfied the initial burden for establishing obviousness because the combination of references does not produce the claimed invention.” Br. 11. Further, the Appellant argues that “even if the combination did produce the claimed invention, there is no objective evidence of suggestion or motivation in the prior art to combine the references in the manner proposed....” Br. 11-12. The Appellant has made these arguments without any specific application to claim 33 or to the rejection. Moreover, statements baldly submitting that limitations are not present in the prior art are not persuasive of error on the part of the Examiner when the Examiner has specified portions of the prior art that describe those limitations. Specifically, we find that the Examiner acknowledged the factual inquiries necessary to support the conclusion of obviousness (Ans. 4-5), and provided the necessary factual support to reach a conclusion of obviousness (Ans. 5-6).

Lastly, the Appellant argues that the evidence of secondary considerations demonstrates the non-obviousness of Appellant’s invention.

Br. 15-16. Specifically, the Appellant argues that evidence of commercial success represents evidence of non-obviousness. Br. 15. As such, we now consider anew the issue of obviousness, carefully evaluating and weighing both the evidence relied upon by the Examiner, and the objective evidence of non-obviousness provided by the Appellant. In particular, we consider the evidence set forth in the Nunn Declaration as it pertains to the obviousness of the subject matter of claim 33.

First, we note that the objective evidence must be commensurate in scope with the claims. Here, the evidence that the Heartburn Treatment Center uses an “Internet-based integrated healthcare delivery system to create patient plans of care, to schedule diagnostic procedures and store the results thereof, and to track patient follow up” (FF 8), is not commensurate in scope with the claimed features of using a computer to solicit from the user a subset of test results selected from the set of possible results for that test, and creating a summary which simultaneously displays the subsets of test results for all of the selected tests.

Second, the Declarant offered evidence of an increasing number of medical procedures and studies being performed (FF 9-11), and of an increasing number of referrals and new patients being treated (FF 12) as a result of using the Internet-based system. However, we find that these statements provides very little evidence of a nexus to the Appellant’s claimed method, because the Appellant has offered insufficient facts to show that these improvements are due to the nature of the claimed invention, as opposed to other economic and commercial factors unrelated to the technical quality of the claimed subject matter. For example, the increasing number of referrals and new patients could be simply attributed to an increased

access to heartburn specialists in particular and medical care in general, as well as to the centralization of heartburn treatment in a single location. Similarly, the increased number of medical procedures and studies being performed could also be attributed to an increased access to heartburn specialists, as well as to the centralization of heartburn treatment in a single location.

After reviewing all of the evidence before us, including the totality of Appellant's evidence, it is our conclusion that, on balance, the evidence of nonobviousness fails to outweigh the evidence of obviousness discussed above and, accordingly, the subject matter of claim 33 would have been obvious to one of ordinary skill in the art within the meaning of 35 U.S.C. § 103(a) at the time Appellant's invention was made.

For the foregoing reasons, the Appellant's arguments do not persuade us that the Examiner erred in rejecting claim 33 as unpatentable over the combined teachings of Coli and Bair. Therefore, the rejection of claim 33, and of claims 34-39, standing or falling with claim 33, is sustained.

Claims 40-49

With respect to claims 40-48, the Appellant argues that the application of Teagarden does not cure the perceived deficiencies of Coli and Bair. Br. 13. Similarly, with respect to claim 49, the Appellant argues that the application of Kraftson does not overcome the perceived deficiencies of Coli and Bair. Br. 14. For the reasons discussed above, we find no deficiencies in the underlying combination of Coli and Bair, and thus the Appellant's arguments are not persuasive.

Accordingly, the Appellant's arguments do not persuade us that the Examiner erred in rejecting claims 40-49. That is, the rejections of claims

40-48 under 35 U.S.C. § 103(a) as unpatentable over Coli in view of Bair and Teagarden, and of claim 49 under 35 U.S.C. § 103(a) as unpatentable over Coli in view of Bair and Kraftson, are sustained.

CONCLUSIONS

1. The Appellant has failed to demonstrate that the Examiner erred in determining that Coli discloses: (i) using a computer to solicit from the user a subset of test results selected from the set of possible results for that test, and (ii) creating a summary which simultaneously displays the subsets of test results for all of the selected tests.
2. The Appellant has failed to demonstrate that the Examiner erred in determining that the claimed invention would have been obvious in view of the teachings of Coli and Bair.

SUMMARY

The decision of the Examiner to reject claims 33-49 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

Appeal 2009-000127
Application 10/027,073

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